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09/627,870	07/28/2000	David H. Sprogis	5014	2817

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EXAMINER

GRAVINI, STEPHEN MICHAEL

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 04/15/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/627,870

Applicant(s)

David H. SPROGIS

Examiner

Stephen M. Gravini

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 3-24-03

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-26 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-26 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

4) Interview Summary (PTO-413) Paper No(s). _____

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). 13

6) Other: _____

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DETAILED ACTION

Priority

1. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application upon which priority is claimed is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention (discussed infra). Domestic priority can not be granted under statute 119(e) because the provisional application is not described to one skilled in the art of cinema advertising to reasonably convey the information, at the time of filing, that the inventor had possession of the claimed invention in the manner provided by the first paragraph of section 112 of title 35 as filed under section 111(a) or section 363. Particular claim language reciting transmission to and association with a first digital projector assembly or reciting common interest identification or data is not discussed in the priority document such that examiner considers priority can be granted.

Claim Rejections - 35 USC § 101

2. Claims 25-26 are rejected under 35 U.S.C. 101 because the claimed method does not recite a useful, concrete and tangible result under *In re Alappat*, 31 USPQ2d 1545 (Fed. Cir. 1994) and *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596

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(Fed Cir. 1998). The independently claimed providing, identifying, generating, and selecting contain recitations of descriptive material (i.e. for storing information or selecting data) that does not exhibit any functional interrelationship with the way in which providing, identifying, generating, and selecting are performed; such that the independently claimed invention does not constitute a statutory process, machine, manufacture or composition of matter under 35 USC 101. These independently claimed features are analogous to a book containing instructions or a compact disc containing music which do not recite a useful, concrete and tangible result and are not patentable under 35 USC 101. Because the independently claimed invention is directed to non-functional descriptive material which does not produce a useful, concrete and tangible result, those claims and claims depending from them, are not permitted under 35 USC 101 as being related to non-statutory subject matter. Also the claimed method steps are not within the technological arts because the claims are limited to any structural or mechanical interaction. The claimed invention is merely an abstract idea without a practical application. It is considered not to have a useful result under the *State Street* decision. However in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

Claim Rejections - 35 USC § 112

3. Claims 1-26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one

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skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Those claims recite the steps:

“a controller for selecting certain stored data for transmission to said first digital projector assembly responsive to movie show schedule information regarding a movie that is to be shown in a theater environment associated with said first digital projector assembly;”

“said processing unit being adapted to provide a first portion to provide a first portion of the data representative of advertisement information to the first digital projector assembly responsive to first theater scheduling information regarding a movie that is to be shown in the first theater;”

“selecting certain stored data from the computer storage unit for transmission to a first digital projector assembly of said plurality of digital projector assemblies responsive to movie identification information regarding a movie that is to be shown in a theater environment associated with said first digital projector assembly;”

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“common interest identification means for identifying a characteristic that each of the members of a first audience has in common, and for producing common interest information;” or

“generating common interest data representative of said common interest characteristic”

are not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Examiner does not find basis in the specification to convey the recited features such that the inventor had possession of the claimed invention at the time of filing. Specifically, the features of transmission to or association with a first digital projector, common interest identification of an audience, or common interest characteristic are not recited in the specification and such that it would be reasonable to convey to those skilled in the art that the inventor had possession of the claimed invention (i.e. the specifically recited features). Since the independent claims are rejected under 35 USC 112, first paragraph, so are the depending claims. However, in order to consider these claims in light of the prior art, examiner will assume that these features were in possession of the inventor at the time of filing.

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4. Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Those claims recite the steps:

“a controller for selecting certain stored data for transmission to said first digital projector assembly responsive to movie show schedule information regarding a movie that is to be shown in a theater environment associated with said first digital projector assembly;”

“said processing unit being adapted to provide a first portion to provide a first portion of the data representative of advertisement information to the first digital projector assembly responsive to first theater scheduling information regarding a movie that is to be shown in the first theater;”

“selecting certain stored data from the computer storage unit for transmission to a first digital projector assembly of said plurality of digital projector assemblies responsive to movie identification information regarding a movie that is to be shown in a theater environment associated with said first digital projector assembly;”

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“common interest identification means for identifying a characteristic that each of the members of a first audience has in common, and for producing common interest information;” or

“generating common interest data representative of said common interest characteristic”

which fail to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Examiner does not find antecedent basis in the specification of the features of the features of transmission to or association with a first digital projector, common interest identification of an audience, or common interest characteristic and are therefore considered indefinite under this section of the statute. Since the independent claims are rejected under 35 USC 112, second paragraph, so are the depending claims. Claims 1 and 15 recite said first digital projector assembly which lacks an early positive antecedent basis from that claim. Claim 14 is further rejected under 35 USC 112, second paragraph, as failing to provide antecedent basis for the recited “said second theater scheduling information.” However, in order to consider these claims in light of the prior art, examiner will assume that these features are not indefinite by having an antecedent basis from the specification.

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5. Claims 17-23 are rejected under 35 U.S.C. 112, sixth paragraph, as not setting a limit on how broadly the Office may construe means-plus-function language under the rubric of reasonable interpretation (please see MPEP 2181). The independently claimed storage means, common interest identification means, selection means, and display means are not construed means-plus-function language under the rubric of reasonable interpretation, because the specification does not provide a clear limit of patentability. These four separate independently claimed means are merely exemplified after the “for” recitation and may incorporate any function that could be taught in the prior art, such as the features of a shopping mall kiosk, local bank, gasoline pump that accepts credit cards and other systems incorporating storage, common interest identification, selection, and display. In order to consider that claim in light of the prior art, examiner will assume that those claims contain a clear limitation under the broadest reasonable interpretation.

Claim Rejections - 35 USC § 102

6. Claims 1-26 are rejected under 35 U.S.C. 102(b) as being anticipated by non-patent literature references PACIFIC BELL WILL DELIVER MOVIES TO THEATERS from the San Francisco Chronicle article by Laura Evenson. In that article the claimed system or method comprising:

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a computer storage unit, including storage means, for receiving for receiving and storing data representative of advertisement information along with information regarding a plurality of advertisements (please see examiner numbered paragraph 10);

a plurality of digital projector assemblies coupled to said computer storage unit for receiving data from said computer storage unit (please see examiner numbered paragraph 12); and

a controller for selecting certain stored data for transmission to said first digital projector assembly responsive to movie show schedule information regarding a movie that is to be shown in a theater environment associated with said first digital assembly or a processing unit coupled to said computer storage unit and a plurality of digital projector assemblies coupled to said processing unit, said plurality of digital projectors assemblies including a first projectors assembly for use in a first theater and a second projectors assembly for use in a second theater, and said processing unit being adapted to provide a first portion of the data representative of advertisement information to the first digital projector assembly responsive to first theater scheduling information regarding a movie that is to be shown in a first theater (please see examiner numbered paragraph 18 and implicit teaching of first and second projector/ theaters based on the 10 theaters disclosed in paragraph 8); or

initializing a computer storage unit for receiving for receiving and storing data representative of advertisement information (please see examiner numbered paragraph 10);

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receiving data from a computer storage unit at a plurality of digital projector assemblies (please see examiner numbered paragraph 12); and

selecting certain stored data from the computer storage unit for transmission to a first digital projector assembly of said plurality of digital projector assemblies responsive to movie identification information regarding a movie that is to be shown in a theater environment associated with said first digital projector assembly (please see examiner numbered paragraph 18 and implicit teaching of first and second projector/ theaters based on the 10 theaters disclosed in paragraph 8); or

common interest identification means for identifying a characteristic that each of the members of a first audience has in common, and for producing common interest information and selection means for selecting a subset of the advertisement information responsive to the common interest information (please see examiner number paragraph 14) and display means for permitting the selected subset of the advertisement information to be displayed to the first audience (please see examiner numbered paragraph 14 or paragraph 12). The claimed computer processing unit, assigned movie times/dates and locations, network coupling, composite framing, first showing, people audience numbering, and exposure log generation including feedback are all implicitly taught in the PACIFIC BELL disclosure.

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Claim Rejections - 35 USC § 103

7. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over an obvious variation of the Cyberstar press release dated November 9, 1998 in view of Ballantyne et al. (US 5,133,079) or in view of Hunter (US 6,424,998). The press release discloses a method and system of movie projector theater advertising comprising:

a computer storage unit or storage means to receive/store advertisement information which can be initialized (content can be send direction to a Windows NT based server);
a plurality of digital projectors or digital projector assemblies receiving information or data from a computer storage unit (see the Shawn Whitcomb statement which implicitly uses digital projector assemblies since that company delivers in-theater media and in-theater media is delivered by digital projector assemblies recognized by the DTDS trademark filed as early as 1999); and

a controller or processing unit for selecting data for transmission in response to signals from an interrelated component (disclosed as Loral Skynet-operated satellites for video and data delivery when used in conjunction with the Windows NT based server). The press release also implicitly discloses the claimed projector computer communications including networking, assigned movie time and location including response, representative advertisement information composite framing, and attendance feedback including first showing information or exposure log reporting. These features are implicit because to those skilled in the art of marketing and advertising, each is a necessary component to marketing and advertising. The press release

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discloses the invention, recited by the applicants, except for the claimed movie identification input unit and the claimed common interest identification means. Ballantyne teaches that it is known to provide a movie identification unit (column 4 lines 20-26) and a common interest identification means (column 6 lines 24-55 in which membership implies common interest identification). Hunter teaches that it is known to provide a movie identification unit (column 10 line 6) and a common interest identification means (column 5 line 5 in which demographic analysis implies common interest identification). It would have been obvious to one skilled in the art of cinema advertising to combine the teachings of the Cyberstar press release with the teachings of Ballantyne or Hunter to provide the claimed movie identification input unit and the claimed common interest identification means for the purpose of allowing inexpensive and reliable cinema advertising. Furthermore, the claimed movie identification input unit and the claimed common interest identification means including movie schedule information are considered merely non-functional descriptive material and do not patentably distinguish the claimed invention from the prior art. Both the claimed movie identification input unit and the claimed common interest identification including movie schedule information means are merely data that is not manipulated to change a structure or process. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore it would have been further obvious to a person of ordinary skill in the art at the time the invention was made to claim any type of identification

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input or any type of identification means because such input or means does not functionally relate to the steps in the invention claimed and because the subjective interpretation of the nature does not patentably distinguish the invention.

Response to Arguments

priority and affidavit

Applicant argues that the provisional application is sufficient to satisfy the statutory requirement under 35 USC 112 for the claimed invention. Examiner disagrees as discussed below under the response to the new matter, enablement, indefiniteness, means/function rejections below. The affidavit submitted by an officer of the assignee is not considered persuasive to overcome examiner's objection with respect to priority, enablement, and indefiniteness. An affidavit from a chief technical officer of an assignee of the claimed invention tends to show a vested interest in interpreting the claimed invention in light of the priority document and its later filed specification. Examiner considers the skill level of the affidavit declarant to be beyond ordinary skill and therefore the affidavit is not considered persuasive to overcome issues raised by the examiner. The affidavit also has not mention of the claimed common interest identification or common interest data which is considered to be enabling in the specification or its priority document such that priority can be granted

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non-statutory subject matter rejections

Applicant argues that claims 25 and 26 have been amended to overcome the non-statutory subject matter rejection. Examiner considers the claimed invention to be purely a business method without structural or mechanical interaction such that the invention falls within the statute governing patentable subject matter. The claim recites providing data storage for identified and received information for selection of further information. This recitation is not considered useful, concrete, and tangible under the rulings cited supra. Therefore the independently claimed invention is considered to contain non-statutory subject matter rejections.

new matter, enablement, indefiniteness, means/function rejections

Examiner and skilled artisans consider the specification discussion of the schedule daemon to be a process that connects job contents to individual movie showings including prioritizing, requesting, approving. The claimed controller for selecting data responsive to movie show schedule information is not considered to be reasonably implied from the specification (i.e. examiner does not consider the data selection in response to movie schedule information to be reasonably conveyed). Applicant also argues exemplary software and hardware for servers provides reasonable conveyance to skilled artisans that the inventor had possession of the claimed feature. Examiner and skilled artisans consider those discussions and figures to relate to the structure necessary to allow data transmission. The claimed controller for selecting data

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responsive to movie show schedule information is not considered to be reasonably implied from those discussions and figures.

Applicant argues that the specification daemon provides reasonable conveyance to skilled artisans that the inventor had possession of the claimed feature. Examiner and skilled artisans consider the specification discussion of the schedule daemon to be a process that connects job contents to individual movie showings including prioritizing, requesting, approving. The claimed processing unit being adapted to provide a first portion to provide a first portion of the data representative of advertisement information to the first digital projector assembly responsive to first theater scheduling information regarding a movie that is to be shown in the first theater is not considered to be reasonably implied from the specification (i.e. examiner does not consider the first digital projector assembly responsive to first theater scheduling information to be reasonably conveyed). Applicant also argues exemplary software and hardware for servers provides reasonable conveyance to skilled artisans that the inventor had possession of the claimed feature. Examiner and skilled artisans consider those discussions and figures to relate to the structure necessary to allow data transmission. The claimed controller for selecting data responsive to movie show schedule information is not considered to be reasonably implied from those discussions and figures.

Applicant argues that the specification provides reasonable conveyance to skilled artisans that the inventor had possession of the claimed feature. Examiner and skilled artisans consider the specification discussion of the schedule daemon to be a process that connects job contents to

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individual movie showings including prioritizing, requesting, approving. The claimed selecting certain stored data from the computer storage unit for transmission to a first digital projector assembly of said plurality of digital projector assemblies responsive to movie identification information regarding a movie that is to be shown in a theater environment associated with said first digital projector assembly is not considered to be reasonably implied from the specification (i.e. examiner does not consider the first digital projector assembly responsive to scheduling information to be reasonably conveyed). Applicant also argues exemplary software and hardware for servers provides reasonable conveyance to skilled artisans that the inventor had possession of the claimed feature. Examiner and skilled artisans consider those discussions and figures to relate to the structure necessary to allow data transmission. The claimed controller for selecting data responsive to movie show schedule information is not considered to be reasonably implied from those discussions and figures.

Applicant argues that the features rejected from claims 17 and 25 are overcome by specification discussion and figure illustration similar to the amended claims above. However examiner and skilled artisans would not find the claimed subject matter to be reasonably conveyed from the specification such that the inventor had possession of the claimed invention. The specification and figures are considered computer network data processing while the claims related to movie information scheduling. It is difficult to find the commonality between the specification/figures and the claims to overcome the 35 USC 112 rejections.

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Applicant argues that sufficient structure exists to overcome the 35 USC 112, sixth paragraph rejection. However the process discussed from the specification is not considered to provide the adequate structure to overcome that rejection.

obviousness rejections

Examiner considers the applicant argument that geographically targeted retail advertising is insufficient to obtain the desired level of targeting that is possible with systems of the claimed invention that the targeted advertisements based on movie show schedule information and movie information. To those skilled in the art targeted retail advertising is based on commonality of intended advertising targets. Whether the commonality is a retail establishment or a movie schedule is irrelevant since the same result occurs in the same way with the same function. The rejection is considered proper and maintained.

8. This is a request for continued examination of applicant's earlier Application. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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a shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

9. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose telephone number is (703) 308-7570 and electronic transmission / e-mail address is "steve.gravini@uspto.gov". Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30 p.m. **If applicant chooses to send information by e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured.** Please see MPEP 502.02. Information may be sent to the Office by facsimile transmission. The Official Fax Numbers for TC-3600 are:

After-final	(703) 872-9327
Official	(703) 872-9326
Non-Official/Draft	(703) 872-9325



**STEPHEN GRAVINI
PRIMARY EXAMINER**

smg
April 10, 2003